

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Toshihiko OGURA

Rule 53(b) Continuation-in-Part Application of U.S.
Patent Application No. 09/942,865 Filed August 31, 2001

Filed: August 13, 2003

Docket No.: 110519.01

For: HEART-SOUND DETECTING APPARATUS AND HEART-SOUND DETECTING
METHOD

PRELIMINARY REMARKS

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

The Advisory Action asserts that the claimed range of the frequency range of above 30 to 300 Hz is not supported by the original disclosure. Applicant respectfully submits that the original disclosure fully supports the recited range of "above 30 to 300 Hz".

Applicant submits that the broadly disclosed range of "30 to 300 Hz" provides support for the presently claimed range of "above 30 to 300 Hz". See the opinion of Judge Learned Hand in Engineering Development Laboratories v. Radio Corp. of America, 153 F.2d 523, 526-27, 68 USPQ 238, 242 (2d Cir. 1946), quoted with approval in In re Driscoll, 562 F.2d 1245, 1250, 195 USPQ 434, 438 (C.C.P.A. 1977):

If, when [applicants] yield any part of what they originally believed to be their due, they substitute a new "invention," only two courses will be open to them: they must at the outset either prophetically divine what the art contains, or they must lay down a barrage of claims, starting with the widest and proceeding by the successive incorporation of more and more detail, until all combination have been exhausted which can by any possibility succeed. The first is an impossible task; the second is a custom already more honored in the breach than in the observance, and its extension would only increase that

surfeit of verbiage which has for long been the curse of patent practice, and has done much to discredit it.

See also In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (C.C.P.A. 1976):

In the context of this invention, in light of the description of the invention as employing solids contents within the range of 25-60% along with specific embodiments of 36% and 50%, we are of the opinion that, as a factual matter, persons skilled in the art would consider processes employing a 35-60% solids content range to be part of appellants' invention and would be led by the Swiss disclosure so to conclude. Cf. *In re Ruschig*, supra. The PTO has done nothing more than to argue lack of literal support, which is not enough. If lack of literal support alone were enough to support a rejection under §112, then the statement of *In re Lukach*, supra, 58 CCPA at 1235, 442 F.2d at 969, 169 USPQ at 796, that "the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of §112," is empty verbiage. The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient.

See also In re Blaser, Germscheid, and Worms, 556 F.2d 534, 538, 194 USPQ 122, 125

(C.C.P.A. 1977), in which a disclosure of a temperature range of 60-200°C was considered sufficient support for a claim recitation of 80-200°C. See also In re Risse, Horlein, and Wirth, 378 F.2d 948, 952-53, 154 USPQ 1, 5 (C.C.P.A. 1967).

As mentioned above, the original specification clearly supports the presently claimed range of "above 30 to 300 Hz", which falls within the disclosed range of "30 to 300 Hz". The recitation in claims 1, 2, 6 and 7 simply excludes a portion of the broader 30 to 300 Hz range, which Applicant expressly discloses in the specification. The disclosure of the broader ranges of 30 to 300 Hz provide sufficient disclosure to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention of present claims 1, 2, 6 and 7.

Reconsideration is thus respectfully requested.

Respectfully submitted,



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